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EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1. This Office Action is in response to **Election** along with its **Pre-Amendment** both filed on July 29, 2008. Applicants have **elected Group I (Claims 1-4) without traverse**. With such a pre-amendment, parent composition Claim 1 is amended to incorporate the limitation of Claim 4; Claim 4 and non-elected Claim 5 (Group II) are both cancelled, while new process Claims 6-8 and new composition Claim 9 are added. **Re-Restriction requirement is found necessary by this Examiner.** **Claims 1-3 and 6-9 are now pending** with only **one** independent claim (Claim 1). An action follows.

DETAILED ACTION

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner as well as by examining the references cited in international search report and IDS filed by Applicants.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following:

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I. **Claims 1-3 and 9**, drawn to **a graft or a block fluoropolymer** comprising at least one kind of **a silicone rubber segment** and at least one kind of **a fluorine containing elastomer segment**.

II. **Claims 6-8**, drawn to **a process of making a graft or a block fluoropolymer** of Group I.

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “**special technical features**” shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

4. In view of international search report for **PCT/JP03/14184** filed on November 7, 2003 by Applicants, Examiner’s own prior art search as well as the references or articles cited in **two IDS** filed so far by Applicants, **Claims 1-3 and 6-9** is either obvious or anticipated by following: **Kojima et al. (US 4,314,043)**, **Heeks et al. (US 5,736,250)** and **Konno et al. (US 5,141,991)**, each individually or in combination. In summary, these two groups have no common features

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in the preparation as well as its application since they are structurally different. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, the block or graft fluoropolymer having two specified segments from Group I and Group II does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate.

5. With respect to the fact that “both groups are **structurally different** each other”, Group I was drawn to **a graft or a block fluoropolymer** comprising at least one kind of **a silicone rubber segment** and at least one kind of **a fluorine containing elastomer segment**, while Group II was drawn to **a process of making a graft or a block fluoropolymer**. The fluoropolymer and its process of making are each unique and thereby not interchangeable. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed in Group II can be applied to make other and materially different product or (2) that the product as claimed in Group I can be made by another and materially different process.

6. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that one phone call was made to **Abraham J. Rosner (registration # 33,276, tel: 202 293-7060)** on **October 20, 2008** to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu** whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796

/Henry S. Hu/
Examiner, Art Unit 1796

October 26, 2008